

REMARKS

Rejections under 35 U.S.C. §102

In the Advisory Action is October 1, 2003, the Examiner indicates the withdrawal of the rejections under 35 U.S.C. §102.

Rejections under 35 U.S.C. §103

In the Advisory Action, the Examiner further maintains the rejection of claims 1-10 and 12-20 under 35 U.S.C. §103 as being obvious over U.S. '760. In response to Applicants' arguments of April 17, 2003, the Examiner states that the only difference between the invention and the prior art is the use of exogenous enzymes for the digestion, which results in a different product. The Examiner asserts that it would be obvious to use exogenous enzymes and that by doing so the product of the invention would be achieved.

However, the Examiner's position is legally flawed in that she has failed to provide any motivation for modifying the prior art of U.S. '760 to use exogenous enzymes.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. §2143

The "factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." The Examiner must present requisite evidence in support of an assertion of motivation. In re Lee, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

The Examiner has only presented the conclusory statements that "it was known in the art that exogenous enzymes can be used to digest mushroom mycelia" and "it is considered an obvious modification of the prior art to use exogenous enzymes for digestion." The Examiner has failed to present any reason for why one skilled in the art would be motivated to use exogenous enzymes. The fact that it was known that exogenous enzyme to digest mushrooms does not provide any motivation to modify U.S. '607 to replace the endogenous enzymes with exogenous enzymes and thereby achieve a different product. As such, the Examiner has failed to meet threshold required for rejecting the invention as being *prima facie* obvious and withdrawal of the rejection is respectfully requested.

As the above remarks address and overcome the rejections, withdrawal thereof and allowance of the claims are respectfully requested.

Appl. No. 09/830,449

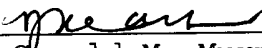
Should the Examiner have any questions regarding the present application, she is requested to please contact MaryAnne Armstrong, PhD (Reg. No. 40,069) in the Washington DC area at (703) 205-8000.

Applicants request a two (2) month extension of time for filing the present response. The required extension fee is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Gerald M. Murphy, Jr., #28,977

MaryAnne Armstrong, Ph.D., #40,069

GMM/MAA:bmp
0230-0161P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000